PATENT

HP Docket No.: 200208213-1
App. Serial No. 10/628,291

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the foregoing amendments and following remarks.

Claims 1, 19, 29, 33, and 36 have been amended. Claims 15-17, 23, and 24 have been canceled without prejudice or disclaimer of the subject matter therein. 1-14, 18-22, and 25-39 are currently pending, of which claims 1, 19, 29, and 33 are independent.

Claim 1, 7, 18, 19, 29, and 33 were rejected under nonstatutory double patenting as allegedly being unpatentable over claims 1-45 of the issued '897 patent (6,813,897).

Claims 1-9, 11-14, 18-19, 21-23, 27-36, and 38-39 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Budelman (5629608).

Claims 10, 20, 25, and 37 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Budelman in view of Bavaro et al. (4,974,272).

Claim 15 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Budelman in view of Lehr et al. (6,473,608).

The above rejections are respectfully traversed.

Telephonic Interview Conducted on September 22, 2006

The undersigned thanks the Examiner for the courtesy extended in the telephonic interview conducted on September 22, 2006. In the interview, various features recited in allowable claims 16, 17, 24, and 26 were discussed.

Non-Statutory Double Patenting

Claim 1, 7, 18, 19, 29, and 33 were rejected under nonstatutory double patenting as allegedly being unpatentable over claims 1-45 of the issued '897 patent (6,813,897). This

rejection is moot in view of amendments to claims 1, 19, 29, and 33. Therefore, withdrawal of such rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-9, 11-14, 18-19, 21-23, 27-36, and 38-39 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Budelman (5629608). However, claims 16, 17, 24, and 26 were indicated as allowable if rewritten to include all the limitations of the base claim and any intervening claims.

Independent Claim 1

Claim 1 has been amended to include the allowable language of claims 15-17 (claim 15 being an intervening claim), and claims 15-17 have been canceled. Accordingly, it is

respectfully submitted that amended claim 1 and dependent claims 2-14 and 18 are allowable over the references of record.

Independent Claim 19

Claim 19 has been amended to include the allowable language of claims 23 and 24 (claim 24 being an intervening claim), and claims 23 and 24 have been canceled. Accordingly, it is respectfully submitted that amended claim 19 and dependent claims 20-22, 25-29, and 31 are allowable over the references of record.

Independent Claim 29

Claim 29 has been amended to include the allowable language of claims 25 and 26 (claim 25 being an intervening claim). Accordingly, it is respectfully submitted that amended claim 29 and dependent claims 30 and 32 are allowable over the references of record.

Independent Claim 33

Claim 33 has been amended to recite the efficient operating point of the primary power supply means is based "on a power factor curve for the primary power supply means." As defined in the present disclosure at Equation 1 on page 2, a power factor is based on a ratio of real power to apparent power, which is a well-known definition in the art. Yet, the final Office Action alleged that in Budelman, a "duty cycle [of a power supply] is a representation of power factor" (Final Office Action, p. 12). It is respectfully submitted that such an alleged definition is incorrect and inconsistent with the common definition of a "power factor." Accordingly, because Budelman fails to disclose the efficient operating point

is based on a correct *power factor* curve, it is respectfully submitted that claim 33 and its dependent claims 34-39 are allowable over the references of record.

Claim Rejections Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 10, 20, 25, and 37 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Budelman in view of Bavaro et al. (4,974,272).

Claim 15 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Budelman in view of Lehr et al. (6,473,608).

It is respectfully submitted that, for at least the reasons set forth earlier, claims 10, 15, 20, 25, and 27 are not anticipated by Budelman. In addition, the Final Office Action relied on neither Bavaro et al. nor Lehr et al. to make up for the deficiencies in Budelman with respect to these claims. Accordingly, claims 10, 15, 20, 25, and 27 are also allowable over the references of record.

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: September 26, 2006 By

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